

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 1-59 will be pending, claims 1, 30, 43, and 49 being independent.

Claims 25-30, 32, 33, 36, 37, 38 stand withdrawn from consideration as being directed to non-elected inventions.

The new claims are all directed to the elected invention (*i.e.*, claim groupings I, II, and III).

### **Summary of the Office Action**

Although the previously imposed restriction requirement is rendered final, Applicants' previously filed petition was granted on November 14, 2003, whereby the restriction has been vacated with regard to claim groupings I, II, and III.

As evidenced by the Examiner-initialled PTO-1449 form, the Examiner has acknowledged his consideration of Applicants' previously filed information disclosure statement.

Applicants' claim of priority and receipt of the certified copy of the priority application are acknowledged on the cover sheet (form PTO-326) of the Office action.

In Section 4, on page 3 of the Office action, the specification is objected to in connection with reference numeral 8a in paragraph 0077.

Claims 2, 5, and 7 are rejected under 35 USC §112, second paragraph, as being indefinite. See Section 6 on page 4 of the Office action.

Claims 1, 2, 5-7, 11, 14-17, 20-24, 31, 34, and 35 are rejected under 35 USC §102(b) over British Patent No. 2 256 784 (GB '784). See Section 8, beginning on page 5 of the Office action.

Claims 3 and 4 are rejected under 35 USC §103(a) as being unpatentable over GB '784 in view of MONTGOMERY et al. (U.S. Patent No. 4,924,606). See Section 10, beginning near the middle of page 7 of the Office action.

**Summary of Decision on Petition and Request for Consideration of Claims 32 and 33**

The decision on petition, dated November 14, 2003, has vacated and withdrawn the previously imposed restriction requirement with regard to the claim groupings I, II, and III. Therefore, it is Applicants' understanding that all claims directed to the sole and boot of the invention will be examined on their merits.

Consistent with that understanding is that claims 25-30, 32, 33, 36, 37, 38, primarily directed to inventive methods, which are directed to claim groupings IV, V, and VI, will remain withdrawn from consideration.

Applicants note, in this regard, that claims 32 and 33 are directed to a boot according to the invention, made by the methods of claims 25 and 30, respectively. Therefore, in the event that parent claims 25 and 30 were to be allowed, Applicants assume that the Examiner would also allow claims 32 and 33.

If Applicants' understanding in this regard is not correct, Applicants request that the restriction requirement be modified and that claims 32 and 33 be examined as to their substantive merits at this time.

In this regard, Applicants would be amenable to writing claims 32 and 33 in independent form if such an amendment would facilitate the examination of these two claims.

**Response to the Office Action****A. Withdrawal of the Objection to the Specification**

In response to the objection to the specification, Applicants have amended paragraph 0077 so that reference numeral 8a has been deleted.

Incidentally, for the purpose of providing proper antecedent basis for the expression "tread members" in new claims 51 and 52, Applicants have additionally amended paragraph 0077.

In view of the amendment, reconsideration and withdrawal of the objection to the specification is kindly requested.

**B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph**

In response to the rejection of claims 2, 5, and 7 under 35 USC §112, Applicants have presented amendments to each of the claims which are believed to resolve the issues raised by the Examiner.

In view of the amendment, reconsideration and withdrawal of the rejection is kindly requested.

If any issue of indefiniteness were to remain, or if the Examiner would prefer different wording in the above-mentioned or other claims, he is invited to contact Applicants' undersigned representative.

**C. Withdrawal of Rejections Under 35 USC §102(b) and §103(a)**

Applicants request that the rejection under both 35 USC §102(b) and 35 USC §103(a) be withdrawn.

First of all, Applicants note that GB '784 is a family member of DE 41 20 136, which is described in detail in paragraphs 0029-0034 in the background section of the specification of the instant application. Further, Applicants note that the European search report of Applicants' priority application identifies GB '784 as being pertinent to the general background of the invention, with regard to claims 1, 22, 26, and 27 of the priority application. That is, it was not identified as being particularly pertinent.

In addition to MONTGOMERY, which the Examiner relies upon in his rejection of claims 3 and 4, Applicants additionally direct the Examiner's attention to U.S. Patents 5,899,006 and 6,216,366 (cited in Applicants' information disclosure statement), which are commonly owned with the instant application, and which are family members of French Patent Publication No. 2 743 989, which is mentioned in paragraph 0027 of the background section of the instant application. Two-part soles are described therein.

Returning to GB '784, Applicants submit that the boot and, particularly, the sole of GB '784 is significantly different from Applicants' invention.

In the example of Figs. 1 and 2, GB '784 shows two separate plates, *i.e.*, front and rear plates 71a, 71b, which are embedded in a rubber frame. At the junction 72, the sole would be very weak. Further, Applicants submit that the rubber peripheral frame 63 would be too weak to be fairly characterized as a reinforcement.

As shown in Fig. 4 of GB '784, the rubber frame runs along the entirety of the shoe and it cannot be considered to be a reinforcement. It is the only structural part of the shoe, the rubber frame being provided to protect the plate from direct contact with the ground and the rubber frame having no significant mechanical role. If one were to remove the frame, there would be no more sole, whereas in the invention, the reinforcement only complements the other two distinct parts, which already form the sole.

It is explained in paragraph 0031 of Applicants' specification that the sole of DE '136 (*i.e.*, the sole of GB '784) has a periphery that is made in one piece. Consequently, with GB '784, a different periphery 63 has to be manufactured for each sole size.

In the rejection, plates 71a, 71b of GB '784 have been identified as front and rear half-soles. In addition, element 63 of GB '784 is identified as a reinforcement.

In contrast, the text of GB '784 itself identifies plates 71a, 71b as "fibre reinforced parts", whereas the peripheral frame 63 is provided for the purpose of fixing threaded studs to the sole.

In Fig. 6 of GB '784, the embodiment of Fig. 4 is enhanced with a reinforcement 67, but the reinforcement 67 is positioned only under the rear part of the foot. Therefore, it adds rigidity to the rear part, but does not add any responsiveness when the front of the sole is flexed. This reinforcement cannot be said to be linked to the front part of the sole, as the sole does not have distinct front and rear parts.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection of claim 1, and the claims depending therefrom, is requested.

Regarding the rejection of claims 3 and 4, for which additional reliance is had on MONTGOMERY, Applicants request that the rejection be withdrawn for reasons additional to those given above.

The primary reference, GB '784, discloses a composite structural sole and *not* a two-part sole that is assembled together. Consequently, Applicants submit that one skilled in the art would not have deconstructed the sole of GB '784 to make a two-part sole, nor to take a two-part sole and make it into a composite sole. That is, Applicants submit that the teachings of GB '784 and MONTGOMERY are incompatible.

### **C. New Claims**

As mentioned above, new claims 40-59 have been added.

Dependent claims 40 and 41 have been added for the purpose of preserving the original scope of claim 7, which was amended in a way that overcomes the indefiniteness rejection, mentioned above.

Dependent claim 42 has been presented in conjunction with an amendment made to original claim 10, whereby the wear pad, which had been specified at the end of claim 10 has been deleted therefrom and added to claim 42.

Claim 43 is a new independent claim. It includes subject matter from original claim 1 and also describes the junction zone of the half-soles and that the junction zone extends at least partially above the reinforcement.

By contrast to claim 43, if element 63 of GB '784 is to be regarded as a "reinforcement", the half-soles do not extend beneath it.

Claim 44 depends from independent claim 43, and adds a limitation that at least one of the front and rear half-soles are constructed to guide and to connect the sole to a sports apparatus.

Claims 45-47 depend from claim 43 and specify the manner in which the half-soles are assembled together.

Claim 48 adds the limitation of an upper to the sole of claim 43, thereby resulting in a "sports boot".

Claim 49 is independent claim directed to a boot according to the invention. Among other limitations, claim 49 calls for the front and rear sole portions to comprise two distinct non-unitary portions assembled together in a junction zone, with the reinforcement structure extending longitudinally through such junction zone. In GB '784, Applicants submit that no reinforcement is provided that extends through a junction zone of front and rear portions of a sole.

Claim 50 depends from claim 49 and further defines the reinforcement structure as having an outer periphery that is spaced from outer peripheries of both of the front and rear sole portions.

In contrast to claim 50, element 63, if regarded a reinforcement, it extends *to* the periphery of the sole and, therefore, cannot be considered to be spaced therefrom.

New claim 51 depends from claim 49 and adds the limitation of tread members extending downwardly from at least one of the front and rear sole portions of the sole.

In contrast to claim 51, any studs of the sole of GB '784 extend from the element 63, which is identified in the Office action as a "reinforcement", not a front or rear sole portion.

New claim 52 depends from claim 49 and also refers to tread members having been molded integrally with the constituent materials of the front and rear sole portions.

Again, this cannot be said of the sole of GB '784.

Still further, claim 53, which depends from claim 49, calls for the reinforcement to be positioned *above* at least parts of the front and rear sole portions.

In contrast with claim 53, element 63 is positioned *below* the front and rear sole portions.

Claim 54 depends from claim 49 and more specifically identifies the location of the junction zone of the front and rear portions of the sole, *i.e.*, substantially rearward of a portion of the sole adapted to correspond to the metatarsophalangeal bending zone of a wearer's foot.

Claim 55, also dependent upon claim 49, specifies that the front and rear portions of the sole overlap one another in the junction zone and that the junction zone has an adjustable length that is dependent upon the size of the sole. Claims 56 and 57 further define the junction zone of claim 55.

Claim 58 depends from claim 49 and further defines the structure of the reinforcement, *i.e.*, comprising at least one laminated or non-laminated plate extending from the junction zone, both on at least half of the front portion of the sole and on at least half of the rear portion of the sole.

Lastly, claim 59 depends from claim 49 and further specifies that the reinforcement structure has a length corresponding substantially to at least 60% of the length of the sole.

#### **SUMMARY AND CONCLUSION**

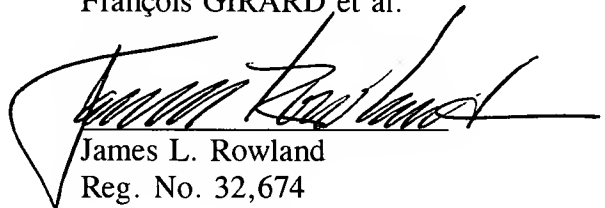
The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

Any fees required for acceptance of this reply as timely and/or complete, including any claim fees, can be charged to Deposit Account No. 19-0089.

Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an additional extension of time were necessary to render this response timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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